

ESTTA Tracking number: **ESTTA567542**

Filing date: **10/28/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
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| Name | Halo Electronics, Inc. |
| Granted to Date of previous extension | 10/27/2013 |
| Address | 2880 Lakeside Drive Suite 116 Santa Clara, CA 95054 UNITED STATES |

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| Attorney information | Lisa Greenwald-Swire P.O Box 1022 Minneapolis, MN 55440-1022 UNITED STATES tmdoctc@fr.com, TrademarkGroup-SV@fr.com |
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Applicant Information

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|------------------------|---|------------------------|------------|
| Application No | 85459212 | Publication date | 04/30/2013 |
| Opposition Filing Date | 10/28/2013 | Opposition Period Ends | 10/27/2013 |
| Applicant | Halo2Cloud, LLC 148 Eastern Blvd Glastonbury, CT 06033 GERMANY | | |

Goods/Services Affected by Opposition

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| Class 009. First Use: 2011/05/00 First Use In Commerce: 2011/05/00 All goods and services in the class are opposed, namely: Ready-to-use accessories for consumer electronic devices, namely, power supply connectors, data cable connectors, Ethernet cable connectors, USB cable connectors, fiber optic cable connectors, and multimedia interface cable connectors, power supply adapters, electric adapters, and plug adapters, power supply cables and data cables in the nature of Ethernet cables, USB cables, fiber optic cables and multimedia interface cables; Battery chargers and rechargers; Accessories for telecommunications devices, namely, earpieces, speakers, and mounting devices; Media players and MP3 players; Portable handheld electronic digital video messengers for recording, storage, transmission or reproduction of visual, audio and data content; and Computer storage devices, namely, external hard drives, blank flash drives and high-speed storage subsystems for storage and backup of electronic and digital data locally and via a telecommunications network |
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Applicant Information

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|------------------------|------------|------------------------|------------|
| Application No | 85459271 | Publication date | 05/07/2013 |
| Opposition Filing Date | 10/28/2013 | Opposition Period Ends | |

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|-----------|---|
| Applicant | Halo2Cloud, LLC 148 Eastern Blvd Glastonbury, CT 06033 GERMANY |
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Grounds for Opposition

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| Priority and likelihood of confusion | Trademark Act section 2(d) |
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Marks Cited by Opposer as Basis for Opposition

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|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1761135 | Application Date | 02/18/1992 |
| Registration Date | 03/30/1993 | Foreign Priority Date | NONE |
| Word Mark | HALO | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 009. First use: First Use: 1991/12/12 First Use In Commerce: 1991/12/12 low power DC/DC converter modules, isolation modules and filters, for use with local area networks (LAN) | | |

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|-----------------------------------|--|------------------|------|
| U.S. Application/Registration No. | NONE | Application Date | NONE |
| Registration Date | NONE | | |
| Word Mark | Halo Logo, depicting the word HALO with a "halo design" above the letter A. Images of said logo are available at http://www.haloelectronics.com/images/remote-power.jpg | | |
| Goods/Services | communication magnetics including signal transformers, filters, CMR chokes and low power DC/DC converters, as well as low power DC/DC converter modules, isolation modules and filters, for use with local area networks (#LAN#) | | |

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| Attachments | Opp to Halo2Cloud Marks - final.pdf(141694 bytes) Opp - Exh A.pdf(20179 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

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|-----------|------------------------|
| Signature | /lisa greenwald-swire/ |
| Name | Lisa Greenwald-Swire |
| Date | 10/28/2013 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Ser. Nos:
85/459,212 for **HALO** in Class 9
85/459,271 for **HALO & Design** in Class 9

Halo Electronics, Inc.,

Opposer,

v.

Halo2Cloud LLC,

Applicant.

Opposition No.: _____


**CONSOLIDATED NOTICE OF
OPPOSITION**

Opposer Halo Electronics, Inc. (“Opposer” or “Halo”), a Nevada corporation, having its principal place of business at 2880 Lakeside Dr., Santa Clara, CA 95054, believes that it will be damaged by registration of the marks shown at Application Serial Nos. 85/459,212 and 85/459,271 (together the “Halo2Cloud Applications,” while the marks that are the subject of these applications shall be referred to as the “Halo2Cloud Marks” or the “Proposed Marks”), and hereby opposes these applications, alleging as grounds for its opposition that:

1. Opposer has timely opposed the challenged trademarks following their publication on the following dates in the *Official Gazette*:
 - a. 85/459,212 for HALO published April 30, 2013, and Opposer requested and received an extension of time to oppose until August 28, 2013, as well as a further consented extension of time to oppose until October 27, 2013.

- b. 85/459,271 for HALO & Design published May 7, 2013, and Opposer requested and received an extension of time to oppose until September 4, 2013, as well as a further consented extension of time to oppose until November 3, 2013.

2. As is evidenced by the publication of the Halo2Cloud Applications in the *Official Gazette*, Applicant Halo2Cloud LLC (“Applicant”) seeks to register the Proposed Marks as trademarks in International Class 9 for the following goods (the “Halo2Cloud Goods”):

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|---|---|
| HALO Ser. No. 85/459,212 HALO & Design Ser. No. 85/459,271  | Class 9: Ready-to-use accessories for consumer electronic devices, namely, power supply connectors, data cable connectors, Ethernet cable connectors, USB cable connectors, fiber optic cable connectors, and multimedia interface cable connectors, power supply adapters, electric adapters, and plug adapters, power supply cables and data cables in the nature of Ethernet cables, USB cables, fiber optic cables and multimedia interface cables; Battery chargers and rechargers; Accessories for telecommunications devices, namely, earpieces, speakers, and mounting devices; Media players and MP3 players; Portable handheld electronic digital video messengers for recording, storage, transmission or reproduction of visual, audio and data content; and Computer storage devices, namely, external hard drives, blank flash drives and high-speed storage subsystems for storage and backup of electronic and digital data locally and via a telecommunications network. First Use May 2011 First Use in Commerce May 2011 |
|---|---|

3. Applicant is, upon information and belief, a Delaware limited liability company, having its principal place of business at 148 Eastern Blvd., Glastonbury, CT 06033.

4. Since at least as early as December 12, 1991, and continuously since then, Halo has used the HALO trade name and trademark in commerce for communication

magnetics including signal transformers, filters, CMR chokes and low power DC/DC converters, as well as low power DC/DC converter modules, isolation modules and filters, for use with local area networks (“LAN”) (the “Halo Goods.”) Opposer has also used Opposer’s Logo (shown below) on or in connection with the Halo Goods since as early as 1991, and continuously since then. Opposer has priority over Applicant’s Proposed Marks.



Opposer’s Logo

5. All of the Halo Goods have been and/or are being advertised, promoted, marketed, offered and rendered in connection with Opposer’s HALO trademark and trade name. We refer to Opposer’s trademark, trade name, and logo as the “Halo Mark.” Opposer has spent considerable time, money, and effort promoting its Halo Mark and developing customer recognition and goodwill in the Halo Mark nationwide, and on Opposer’s website at <www.haloelectronics.com>.

6. Opposer’s rights in the Halo Mark are further evidenced by its ownership of United States Registration No. 1,761,135 for the word mark HALO. We refer to the foregoing registration as “the Halo Registration.” A true and correct copy of the certificate of registration for the Halo Registration is attached hereto as **Exhibit A**. This registration is in full force and effect, and has achieved incontestable status. Opposer’s federal trademark registration for the Halo Mark serves as conclusive evidence of: (a) the validity of the registered mark; (b) Opposer’s ownership of the mark; and (c) Opposer’s

exclusive right to use the mark in commerce under 15 U.S.C. § 1115(b). Opposer also owns several registrations for the mark HALO worldwide.

7. The Halo Mark has been advertised, promoted, marketed and offered in connection with the Halo Goods since at least as early as 1991, and has since then been in continuous and uninterrupted use in interstate commerce.

8. There is no issue as to priority. Opposer has used its Halo Mark for nearly twenty-two years. On information and belief, Applicant has started commercial use of the Proposed Mark no earlier than May 2011, the earliest purported first use date for its Halo2Cloud Marks – this is nearly two decades after Opposer’s first use date.

9. The Proposed Marks are confusingly similar to Opposer’s Halo Mark. The Applicant’s proposed HALO and HALO & Design marks are identical to Opposer’s Halo Mark in sight, sound, and commercial impression, as HALO is the most dominant and distinctive element of the Proposed Marks.

10. Furthermore, Applicant appears to use a logo, as identified in Applicant’s HALO & Design mark, Application Ser. No. 85/459,271, which is near-identical to the Opposer’s Logo, which features a halo over the word HALO. Applicant’s “halo design” above the letter “H” bears a striking resemblance to the “halo design” above the letter “A” in the Halo Logo. **See below.**



Opposer’s Logo



Applicant's Logo

11. Applicant's listed goods in Application Serial Nos. 85/459,212 and 85/459,271 overlap with and/or are related to the Halo Goods. Applicant's Goods include power supply adaptors, chargers, among other goods, all related to consumer electronic devices, which are very similar to Opposer's communication magnetics and power converter products. It is likely that Applicant's targeted consumer base will significantly overlap with Opposer's targeted consumer base, as both are businesses that relate to consumer electronic devices.

12. Applicant's use of the Proposed Marks is likely to cause confusion, mistake or deception in the minds of prospective purchasers as to the origin, source, sponsorship or association of Applicant's goods, thereby causing loss, damage and injury to Opposer. The extent of potential confusion among consumers between Applicant's Proposed Marks and the Halo Mark is substantial.

13. Applicant's use of the Proposed Marks does or is likely to falsely suggest a relationship between Applicant's goods and Opposer's goods. Such use of the Proposed Marks is likely to cause confusion, mistake, or deception with respect to the source or sponsorship of Applicant's goods. Such use is thus likely to cause a significant increase in the level of Applicant's sales and Internet traffic due to consumers' mistaken belief that Opposer is the source or sponsor of Applicant's goods. Applicant's use of the

Proposed Marks is therefore likely to result in Applicant's trading off and benefiting from the goodwill associated with Opposer, resulting in ill-gotten gains by Applicant.

14. Registration of Applicant's Proposed Marks would be a further source of damage to Opposer because it would confer upon Applicant various statutory presumptions to which it is not entitled in view of Opposer's prior use of its distinctive Halo Mark.

15. On information and belief, Applicant was aware of Opposer prior to its adoption of the Proposed Marks.

16. On information and belief, Applicant was aware of Opposer's Halo Mark prior to its adoption of the Proposed Marks.

17. Applicant applied for registration of the Proposed Marks without the consent or agreement of Opposer.

18. For the foregoing reasons, the registrations sought by Applicant are contrary to the provisions of Section 2 of the Lanham Act, 15 U.S.C. §§ 1052 and Opposer would be damaged thereby.

19. In order to protect the public against confusion and deceit, and to protect Opposer's Halo Mark from infringement and unfair competition, registration of Applicant's Proposed Marks should be refused under Sections 2(d) and 13 of the Lanham Act, 15 U.S.C. §§ 1052(d) and 1063.

WHEREFORE, Opposer respectfully prays for the following:

a. a finding that Opposer Halo has priority as to Applicant's Halo2Cloud Marks, as identified in Application Serial Nos. 85/459,212 and 85/459,271, in connection with the Halo2Cloud Goods;

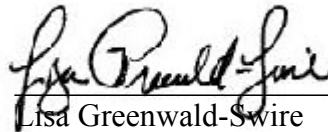
b. a finding that Applicant's Proposed Marks are likely to cause confusion with Opposer's Halo Mark; and

c. pursuant to Section 13 of the Lanham Act, 15 U.S.C. § 1063, that the opposition be sustained and Application Serial Nos. 85/459,212 and 85/459,271, and the marks therein sought, for the goods identified therein, be denied and refused.

This Consolidated Notice of Opposition is submitted electronically. Please apply the fee to Deposit Account No. 06-1050, making reference to 22168-0024PP1.

Respectfully Submitted,

Date: October 28, 2013



Lisa Greenwald-Swire

Kathy Tsai

FISH & RICHARDSON P.C.

Fish & Richardson P.C.

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ATTORNEY FOR

Opposer Halo Electronics, Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the foregoing Consolidated Notice of Opposition has been served this 28th day of October 2013, by mailing said copy via First Class Mail postage prepaid, to the below-identified Applicant/Attorney at his/her place of business:

TUCKER GRIFFITH
MCCORMICK PAULDING & HUBER LLP
185 ASYLUM STREET
18TH FLOOR
HARTFORD, CONNECTICUT 06103-3410

Attorney for Applicant

/s/ Margaret M. Trevino

Margaret M. Trevino

Int. Cl.: 9

Prior U.S. Cl.: 21

United States Patent and Trademark Office

Reg. No. 1,761,135

Registered Mar. 30, 1993

**TRADEMARK
PRINCIPAL REGISTER**

HALO

HALO ELECTRONICS, INC. (CALIFORNIA
CORPORATION)
3698C HAVEN
REDWOOD CITY, CA 94063

TERS, FOR USE WITH LOCAL AREA NET-
WORKS (LAN), IN CLASS 9 (U.S. CL. 21).
FIRST USE 12-12-1991; IN COMMERCE
12-12-1991.

FOR: LOW POWER DC/DC CONVERTER
MODULES, ISOLATION MODULES AND FIL-

SER. NO. 74-246,849, FILED 2-18-1992.

KEVIN PESKA, EXAMINING ATTORNEY